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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,710	10/24/2001	Gary E. LeGrow	2001US405	2771

25255 7590 04/20/2004

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,710

Applicant(s)

LEGROW ET AL.

Examiner

Blessing M. Fubara

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/03/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges receipt of amendment, request for extension of time, IDS and office action for application serial number 10/001,293 filed 02/03/04. Claims 1-9 and 11-19 are pending.

1. Applicants' arguments with respect to claims 1-9 and 11-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9, 11 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Legrow et al. (US 6,143,309).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Legrow discloses lotion and ointment formulations that contain 2% caprylyl trimethicone (example 6) and further discloses topically applying the lotion or ointment to human skin

Art Unit: 1615

(column 7, lines 58-64). Lotion is a known emulsion as can be seen in page 102 of

McCutcheon's Emulsifiers & Detergents, 1986, North American Edition. Caprylyl trimethicone is a trimethylsilyl-n-octylsilsesquioxanes, which is a specific trimethylsilyl-alkylsilsesquioxane.

The teaching of Legrow meets the limitations of the claims.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-9 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by LeGrow et al. (US 5,932,231) in view of Legrow et al. (US 6,143,309).

LeGrow discloses a cosmetic formulation that comprises branched alkylsilsesquioxane of the general formula recited in instant claim 1 (abstract). In the general formula, R is a monovalent hydrocarbon of from 6-14 carbon atom such as hexyl, n-hexyl, I-hexyl, heptyl, n-octyl, i-octyl, nonyl, decyl, dodecyl and tetradecyl; x is from 1 to about 6 and the formulation is substantially free of alkoxysilane, chlorosilane, silanol functionalities and free of organic and inorganic compounds (abstract, column 2, lines 1-7 and 34-54 and claims 1-7 and 22). In example 3, the colorless odorless liquid of the silsesquioxane comprises 60% tris(trimethylsiloxy)n-octylsilane, 25% tetrakis(trimethylsiloxy)-1,3-di-n-octyldisiloxane, 9% pentakis(trimethylsiloxy)-1,3,5-tri-n-octyltrisiloxane and 4% of higher oligomers (column 6, lines 8-15).

Instant claim 1 requires the composition to have from 0.1 to 60% of at least one trimethylsilylalkyl-silsesquioxane and the prior art's 25% tetrakis(trimethylsiloxy)-1,3-di-n-octyldisiloxane or 9% pentakis(trimethylsiloxy)-1,3,5-tri-n-octyltrisiloxane meets the limitation

Art Unit: 1615

in claim 1 since one of the trimethylsilylalkyl-silsesquioxane in the prior art is 25% or 9% or 4%. Leave on composition for personal care is future intended use and future intended use is not critical in a composition claim.

LeGrow teaches the composition of the instant claims except that LeGrow fails to teach an emulsion. However, Legrow in the 6,143,309 Patent discloses a lotion or ointment formulation that comprises caprylyl trimethicone, which is a trimethylsilyl-n-octylsilsesquioxanes, and which is a specific trimethylsilyl-alkylsilsesquioxane. The Legrow 6,143,309 reference is thus relied upon for a teaching that trimethylsilyl-alkylsilsesquioxane can be formulated as a lotion; and a lotion is an emulsion. Regarding microemulsion or triple emulsion, there is no disclosure in applicants' specification providing the particle size and a showing that the microemulsion or triple emulsion provides unusual results.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the alkylsilsesquioxane cosmetic formulation of LeGrow. One having ordinary skill in the art would have been motivated to prepare the formulation of LeGrow as an emulsion according to the teaching of Legrow 6,143,352 with the expectation that the trimethylsilyl-alkylsilsesquioxane lotion formulation would not irritate the skin upon application of the lotion.

6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legrow et al. (US 6,143,309).

Legrow discloses the formulation of the instant claims. Legrow does not disclose microemulsion or triple emulsion. However, there is no disclosure in applicants' specification providing the particle size and a showing that the microemulsion or triple emulsion provides

Art Unit: 1615


unusual results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the lotion of Legrow. One having ordinary skill in the art would have been motivated to prepare the lotion of Legrow with the expectation that the lotion would not irritate the skin. In the absence of a showing, a microemulsion or triple emulsion provides no patentable distinction over the lotion of the prior art.

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Blessing M. Fubara whose telephone number is (571) 242-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara 
Patent Examiner
Tech. Center 1600